



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/818,006 | 03/27/2001 | Merrill W. Harriman | SAA-0058 | 2027 |

23569 7590 03/01/2005

SQUARE D COMPANY
INTELLECTUAL PROPERTY DEPARTMENT
1415 SOUTH ROSELLE ROAD
PALATINE, IL 60067

EXAMINER

CHRISTMAN, KATHLEEN M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3713

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,006

Applicant(s)

HARRIMAN, MERRILL W.

Examiner

Kathleen M Christman

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 3713

DETAILED ACTION

In response to the amendment filed 12/10/2004, claims 28 and 29 have been cancelled; claims 1-27 are pending.

Drawings

1. The drawing was received on 12/10/2004. The drawing is not approved. The drawing includes new matter which was not disclosed in the specification as originally filed. This is further explained in the discussion of claims 15-27 below.

Information Disclosure Statement

2. The information disclosure statement filed 07/22/04 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). The information disclosure statement filed further fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of a "training means" is not fully

Art Unit: 3713

described in the specification as originally filed. The specification does not implicitly or inherently set forth the structure, materials, or acts corresponding to a means-plus-function language in the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Further regarding claim 15, the limitation of "training means" is indefinite. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994). One of ordinary skill in the art would not be able to identify the structure, material or acts from the description in the specification for performing the recited function.

Claims 16-27 are rejected for their incorporation of one or more of the above through their dependencies.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3713

invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-11, 13-18, 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al (US 5535422) in view of Mustafa (US 2002/0059378 A1). Regarding claim 1, Chiang et al teaches a system and method for training a user on a software product, wherein the user is provided a training hyperlink option in response to the user encountering difficulties, or an error as in claim 3, with programming, and linking the user to customized training resources addressing the difficulties based on the information, so as to provide the user solutions to the difficulties (see col. 18: 65-67). Information is retrieved upon selection of the training hyperlink; see the description of the "Show-Me" features. The training hyperlink option provided in response to a request by the user (claim 2) is taught at col. 18: 55-57. The information comprising data indicating at least one part of the software being used by the user (claim 4) is taught at col. 19: 9-11.

Chiang et al fails to teach that information is communicated automatically over a communications network (claim 1), that training resources comprise materials are: presented at an internet web-site (claim 6), are multimedia presentations (claim 7), or a link to a customer service representative (claim 8), that the communications network is a secure network (claim 9) or a private internal network (claim 10), that the training resources are modifiable (claim 13) and can be modified without changes to the software (claim 14).

Mustafa teaches that a communications network for transferring help information in paragraph 04. The various networks and types of training materials are taught in paragraphs 28-30. The ability to modify the training resources without changing the product is taught in the description and use of the "client profile". Specifically, see paragraph 41, which discusses downloading updated information to the user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to update the features of the Chiang et al invention with the on-line features of the Mustafa invention so as to provide for a more diverse help feature.

Art Unit: 3713

It is noted that neither the Chiang et al nor Mustafa inventions are directly drawn to the "software for programming a programmable logic controller". It is the examiner's position that the specific claimed application of the software is not a patentably distinguishing feature. It is old and well known in the art that various software packages may be used during the process of writing the code for programming a programmable logic controller. The Chiang et al invention is drawn to providing help when a user encounters difficulties in a generic software program and as such is equally applicable to any software product. The Mustafa invention is drawn to a general help feature and not limited to any particular product. As no stated problem has been solved nor unexpected result achieved the implementation of the help system in the software product for programming a PLC is deemed a matter of design choice.

Claims 15-18, and 20-24 are a system which corresponds in scope to the method claims 1-4, 6-11, 13 and 14, respectively, and are rejected for the same reasons.

Regarding claims 25 and 26, the limitations of these claims are taught in the "Monitoring User Actions" section of Chiang et al, see col. 15.

Regarding claim 27, the claim represents an intended use of the user device as it is disclosed in claim 15. It is the examiner's position that the computer system of Chiang et al is capable of performing this function.

Regarding the newly added limitation to claim 1 (previously the limitation of claim 29), the applicant has admitted that it is an old and well-known principle in the educational field that student's learn a task more efficiently when they perform the task, rather than by having the task performed for them (see the discussion below). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Chiang et al invention to provide the student with a "walkthrough" type feature allowing the student to perform the steps necessary to overcome any difficulties encountered instead of having the computer tutorial system perform these steps, so to reinforce the proper procedures and allow the student to more efficiently learn the task.

6. Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al (US 5535422) in view of Mustafa (US 2002/0059378 A1) further in view of Gardner et al (US 5239617).

Art Unit: 3713

Chiang et al and Mustafa teach all the limitations of the claimed invention as shown above except for the information containing data indicating at least one particular error made by the user. Gardner et al clearly teaches this ability at col. 5: 4-9. It would have been obvious to one of ordinary skill in the art to combine the abilities of Gardner to point out a specific error with the inventions of Chiang et al and Mustafa so as to provide an intelligent help system which is tailored to the user's specific needs.

Response to Arguments

7. Applicant's arguments filed 03/03/2004 have been fully considered but they are not fully persuasive.

35 USC §112, first paragraph rejection of claims 15-27

The applicant argues that the limitation "training means" is shown in Figure 2 as element 230 and discussed in the paragraph beginning on page 6 line 16 and in Figure 3 as element 330 and discussed in the two paragraphs beginning at page 7 line 7 of the specification. The applicant states that one of ordinary skill in the art would clearly recognize that the training means includes a receiving device for receiving difficulties and a transmitting device for transmitting signals. The examiner respectfully disagrees. The cited portions of the specification do make mention of the "training means" and do describe the functionality of the training means as the means is used in the claims. However, the cited disclosures make no mention of how the training means is actually embodied. For example, is the training means a physical circuit, which performs the functionality, or is it merely a software code included in the memory of one of the devices. The proposed amendments to the drawings do not clarify this issue, and they also add device structures, which were not disclosed in the specification as originally filed. If a claim limitation invokes 35 U.S.C. 112, paragraph 6, it must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." See 35 U.S.C. 112, paragraph 6. See also *B. Braun Medical, Inc. v. Abbott Lab.*, 124F.3d 1419, 1424, 43 USPQ2d

Art Unit: 3713

1896, 1899 (Fed. Cir. 1997). In considering whether there is 35 U.S.C. 112, paragraph 1, support for a means- (or step) plus-function claim limitation, the examiner must consider not only the original disclosure contained in the summary and detailed description of the invention portions of the specification, but also the original claims, abstract, and drawings. A means- (or step-) plus-function claim limitation is adequately described under 35 U.S.C. 112, paragraph 1, if: (1) The written description adequately links or associates adequately described particular structure, material, or acts to the function recited in a means- (or step-) plus-function claim limitation; or (2) it is clear based on the facts of the application that one skilled in the art would have known what structure, material, or acts perform the function recited in a means- (or step-) plus-function limitation. The examiner maintains that neither of these criteria have been met. The examiner maintains that one of ordinary skill in the art would not recognize the particular materials, structure or acts to the structure that constitute the training means as envisioned by the applicant and that as such one of ordinary skill in the art could not make and use the invention as claimed without undue experimentation.

Rejection of claims 1-11 and 13-27 under 35 USC §103

The applicant has traversed the examiner's taking of Official Notice. The applicant states "Although having a student perform a task is sometimes considered useful in the educational field, this is only true for some tasks, and not all tasks." The examiner took official notice that it is an old and well-known principle in the educational field that student's learn a task more efficiently when they perform the task, rather than by having the task performed [for] them. MPEP §2144 states:

If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will

Art Unit: 3713

not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

In the instant case the examiner believes that the applicant has not adequately traversed the taking of official notice. The applicant states that the finding by the examiner is true, in at least some cases. The examiner has not asserted that the only way a student can learn a task is by doing it, but merely that is old and well-known that student's learn tasks more efficiently through performing the task themselves. The examiner has not attempted to state that this is the case in every possible situation, as applicant appears to argue. Further, the mere fact that having all the student's perform a task would require them to each be equipped, does not mean that the student's wouldn't learn the task more efficiently from performing it, but merely that the educational facility has chosen not to commit the funds to providing the student's with the equipment to perform the task on their own. As the applicant has not adequately challenged the taking of official notice the feature is now considered admitted prior art. The examiner also notes, that the applicant has requested documentary evidence supporting the taking. The examiner cited the Harrison et al reference in the previous office action and specifically stated that it was cited in support of the official notice.

The applicant also argues that the combination of the above feature with the Mustafa et al reference is non-obvious. Stating that they are unaware of any system which includes such a feature combined with a programmable logic controller. Applicant further argues that since all the cited references take an entirely different approach, it is evident that the feature was not

Art Unit: 3713

considered useful or obvious in PLC training. These assertion are purely the opinions of the applicant and do constitute any substantial evidence as to why one of ordinary skill in the art would not be motivated to include the feature as suggested by the examiner. The examiner established a prima facie case of obvious in the prior office action. The reasoning has been clarified in the rejection of the claims, but remains consistent with the prior office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M. Christman
February 23, 2005



XUAN M. THAI
SUPERVISORY PATENT EXAMINER

A113713